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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,628	11/20/2001	Masahiko Matsuura	204552021800	8792

25227 7590 12/19/2002

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EXAMINER

CHEN, SOPHIA S

ART UNIT	PAPER NUMBER
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2852

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,628

Applicant(s)

MATSUURA ET AL.

Examiner

Sophia S. Chen

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment.

DETAILED ACTION

Election/Restrictions

1. Mr. Barry Bretschneider had elected the invention III, claim 13, with traverse on 11/14/02. Therefore, claims 1-12 are withdrawn from consideration. A copy of the communication between Mr. Barry Bretschneider and Examiner Dicus is attached.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: T2 (Figure 1) and 1 (Figures 4, 5, and 6). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Figures 10 and 11 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because the sectional cross-hatching of reference numeral 2 (Figure 1) is incorrect. See MPEP §608.02. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The disclosure is objected to because of the following informalities:

- a. Page 6, para [0019], line 1, "claim 1 and claim 2" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- b. Page 6, para [0020], line 1, "claim 3" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- c. Page 6, para [0021], line 1, "claim 4" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- d. Page 7, para [0022], line 1, "claim 5" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- e. Page 7, para [0023], line 1, "claim 6" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.

- f. Page 7, para [0024], line 1, "claim 7" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- g. Page 7, para [0025], lines 1-2, "claim 8 through claim 11" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- h. Page 7, para [0026], line 1, "claim 12 & claim 13" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- i. Page 7, para [0027], line 2, "claim 1" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- j. Page 8, para [0028], line 1, "claim 2" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- k. Page 8, para [0028], lines 2-3, "claim 1" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- l. Page 8, para [0029], line 1, "claim 3" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.

- m. Page 8, para [0029], lines 2-3, "claim 2" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- n. Page 8, para [0030], line 1, "claim 4" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- o. Page 8, para [0030], lines 2-3, "claim 3" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- p. Page 8, para [0031], line 1, "claim 5" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- q. Page 8, para [0031], lines 2-3, "claim 1, 2, 3 or 4" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- r. Page 8, para [0032], line 1, "claim 6" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- s. Page 9, para [0033], line 2, "claim 7" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.

- t. Page 9, para [0033], line 3, "claim 6" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- u. Page 9, para [0034], line 1, "claim 8" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- v. Page 9, para [0035], line 1, "claim 9" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- w. Page 9, para [0035], lines 2-3, "claim 8" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- x. Page 9, para [0036], line 1, "claim 10" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- y. Page 9, para [0036], line 3, "claim 8 or 9" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- z. Page 10, para [0037], line 1, "claim 11" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.

- aa. Page 10, para [0037], line 3, "claim 8 or 9" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- bb. Page 10, para [0038], line 1, "claim 12" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- cc. Page 10, para [0039], line 1, "claim 13" should not be in the content of the specification because the claim numberings will be changed during the prosecution of the application.
- dd. Page 22, lines 2-3, "the --- brush roller 25 is applied --- roller 26 is grounded" is not consistent with Figure 5.
- ee. Page 45, line 5, "our" should be "out".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takaharu, JP 2000-250249 (cited in PTO Form-1449 dated 2/8/02), in view of Tadokoro et al., U.S. Pat. No. 5,113,226.

Takaharu discloses an image forming apparatus comprising a non-fixing type image receiving sheet S; a large number of concave portions s21 accepting toner particles and a large number of convex portions s22 protecting toner particles being formed on a surface of the image receiving sheet S; and a transferring apparatus 5.

Takaharu differs from the instant claimed invention in not disclosing a sheet charging apparatus for charging the surface of the image receiving sheet to polarity opposite to a charged polarity of toner particles, in advance of a transferring process carried out by the transferring apparatus.

Tadokoro discloses an image forming apparatus comprising an image carrier 1; a transferring apparatus 3; a transferring process carried out by the transferring apparatus 3 at position T (Figure 1); and a sheet charging apparatus 7 for charging a surface of a sheet 10 to a polarity opposite to a charged polarity of toner particles, in advance to a transferring process T carried out by the transferring apparatus 3 (column 4, lines 39-44 and 51-55 and Figure 1).

Art Unit: 2852

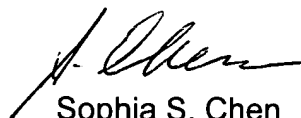
It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the charging apparatus and transferring apparatus as taught by Todokoro in place of the transferring apparatus of Takaharu because of the same functionality for transferring the toner particles to the image receiving sheet.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sophia S. Chen whose telephone number is (703) 308-7617. The examiner can normally be reached on M-F (7:00-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (703) 308-1373. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


Sophia S. Chen
Primary Examiner
Art Unit 2852

ssc
December 18, 2002

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a non-fixing image classified in class 428, subclass 195.
 - II. Claim 12, drawn to a method for forming a non-fixing image classified in class 101, subclass 483.
 - III. Claim 13, drawn to an image apparatus, classified in class 399, subclass 154.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case a corona treating apparatus may be used to charge the surface of an image-receiving sheet.

3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a surface of an image receiving sheet may be charged to an equivalent polarity.

4. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice

Attachment

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another and materially different process. (MPEP § 806.05(e)). In this case an image may be formed and transferred by hand.

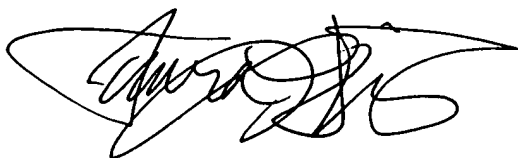
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Barry Bretschneider on 11/14/02 a provisional election was made with traverse to prosecute the invention of III, claim 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774

November 19, 2002